

DOCKET NO.: MSFT-0109/127334.9

PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Marcus Peinado et al.

Application No.: 09/482,840

Filing Date: January 13, 2000

Confirmation No.: 2768

Group Art Unit: 3625

Examiner: Cuong H. Nguyen

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APR 21 2003
GROUP 3600

For: METHOD FOR OBTAINING A BLACK BOX FOR PERFORMING
DECRYPTION AND ENCRYPTION FUNCTIONS IN A DIGITAL RIGHTS
MANAGEMENT (DRM) SYSTEM

DATE OF DEPOSIT:

Apr. 15 2003

I HEREBY CERTIFY THAT THIS PAPER IS BEING
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Steven H. Meyer

TYPED NAME: Steven H. Meyer

REGISTRATION NO.: 37,189

Box ☒ NON-FEE
☐ AF

Assistant Commissioner for Patents
Washington DC 20231

Sir:

REPLY TRANSMITTAL LETTER

Transmitted herewith for filing in the above-identified patent application is:

- ☐ A Preliminary Amendment.
- ☒ An Amendment Responsive to the Office Action Dated January 16, 2003.
- ☐ An Amendment Supplemental to the Paper filed
- ☐ Other:
- ☐ Applicant(s) has previously claimed small entity status under 37 CFR § 1.27.

- ☐ Applicant(s) by its/their undersigned attorney, claims small entity status under 37 CFR § 1.27 as:
- ☐ an Independent Inventor
 - ☐ a Small Business Concern
 - ☐ a Nonprofit Organization
- ☐ This application is no longer entitled to small entity status. It is requested that this be noted in the files of the U.S. Patent and Trademark Office.
- ☐ Loss of Entitlement Enclosed
- ☐ Substitute Pages of the Specification are enclosed.
- ☐ An Abstract is enclosed.
- ☐ Sheets of Proposed Corrected Drawings are enclosed.
- ☐ A Certified Copy of each of the following applications: is enclosed.
- ☐ An Associate Power of Attorney is enclosed.
- ☐ Information Disclosure Statement.
- ☐ Attached Form 1449.
 - ☐ A copy of each reference as listed on the attached Form PTO-1449 is enclosed herewith.
- ☐ Appended Material as follows:
- ☐ Other Material as follows:

FEE CALCULATION

☒ No Additional Fee is Due.

				SMALL ENTITY		NOT SMALL ENTITY	
	REMAINING AFTER AMENDMENT	HIGHEST PAID FOR	EXTRA	RATE	FEE	RATE	FEE
TOTAL CLAIMS	75	75	0	\$9 EACH	\$	\$18 EACH	\$-0-
INDEP. CLAIMS	5	5	0	\$42 EACH	\$	\$84 EACH	\$-0-
FIRST PRESENTATION OF MULTIPLE DEPENDENT				\$140	\$	\$280	\$
<input type="checkbox"/> ONE MONTH EXTENSION OF TIME				\$55	\$	\$110	\$
<input type="checkbox"/> TWO MONTH EXTENSION OF TIME				\$205	\$	\$410	\$
<input type="checkbox"/> THREE MONTH EXTENSION OF TIME				\$465	\$	\$930	\$
<input type="checkbox"/> FOUR MONTH EXTENSION OF TIME				\$725	\$	\$1450	\$
<input type="checkbox"/> FIVE MONTH EXTENSION OF TIME				\$985	\$	\$1970	\$
<input type="checkbox"/> LESS ANY EXTENSION FEE ALREADY PAID				minus	(\$)	minus	(\$)
<input type="checkbox"/> TERMINAL DISCLAIMER				\$55	\$	\$110	\$
<input type="checkbox"/> OTHER FEE OR SURCHARGE AS FOLLOWS:							
TOTAL FEE DUE					\$		\$-0-

☐ A check in the amount of \$.00 is attached. Please charge any deficiency or credit any overpayment to Deposit Account 23-3050.

☐ Petition is hereby made under 37 CFR § 1.136(a) (fees: 37 CFR § 1.17(a)(1)-(4) to extend the time for response to the Office Action of to and through comprising an extension of the shortened statutory period of month(s).

☒ The Commissioner is hereby requested to grant an extension of time for the appropriate length of time, should one be necessary, in connection with this filing or any future filing submitted to the U.S. Patent and Trademark Office in the above-identified application during the pendency of this application. The Commissioner is further authorized to charge any fees related to any such extension of time to Deposit Account 23-3050. This sheet is provided in duplicate.

☒ The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 23-3050. This sheet is provided in duplicate.

☐ The foregoing amount due for filing this paper.

☒ Any additional filing fees required, including fees for the presentation of extra claims under 37 CFR § 1.16.

DOCKET NO.: MSFT-0109

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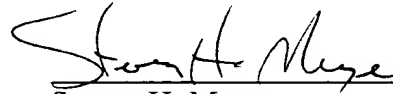
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☒ Any additional patent application processing fees under 37 CFR § 1.17 or 1.20(d).

SHOULD ANY DEFICIENCIES APPEAR with respect to this application, including deficiencies in payment of fees, missing parts of the application or otherwise, the U.S. Patent and Trademark Office is respectfully requested to promptly notify the undersigned.

Date:

April 11 2003



Steven H. Meyer

Registration No. 37,189

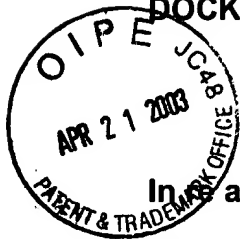
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In application of:

Marcus Peinado et al.

Serial No.: 09/482,840

Group Art Unit: 3625

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Examiner: Cuong H. Nguyen

For: **METHOD FOR OBTAINING A BLACK BOX FOR PERFORMING
DECRYPTION AND ENCRYPTION FUNCTIONS IN A DIGITAL RIGHTS
MANAGEMENT (DRM) SYSTEM**

I, Steven H. Meyer, Registration No. 37,189 certify that this correspondence is being deposited with the U.S. Postal Service as First Class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231 on April 15, 2003.

Registration No: 37,189

Assistant Commissioner
for Patents
Washington, D.C. 20231

Dear Sir:

REQUEST FOR RECONSIDERATION

The following Request for Reconsideration is submitted in response to the Office Action issued on January 16, 2003 (Paper No. 6) in connection with the above-identified patent application, and is being filed within the three-month shortened statutory period set for a response by the Office Action.

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Claims 106-181 are pending in the present application, and stand rejected. Applicants respectfully request reconsideration and withdrawal of the rejection of such claims.

Preliminarily, Applicants note that the Disposition of Claims section on the coversheet of the present Office Action is inconsistent with the state of the application and the contents of the Office Action. In particular, the Disposition of Claims section incorrectly notes that claims 1-181 are pending and claims 1-105 have been withdrawn from consideration. Applicants respectfully submit that in point of fact, claims 106-181 are pending, and that claims 1-105 have been canceled.

The Examiner has rejected claims 106-181 under 35 USC § 103(a) as being obvious over Krishnan (U.S. Patent No. 6,073,124) in view of Stefik (U.S. Patent No. 5,715,403), and further in view of the "Official Notice". Applicants respectfully traverse the § 103(a) rejection of claims 106-181.

Independent claim 106 recites a method in combination with a digital rights management (DRM) system operating on a computing device, where the DRM system employs a black box for performing decryption and encryption functions. The method is for obtaining the black box by the DRM system from a black box server. In the method, the DRM system requests the black box from the black box server and the black box server generates the black box, where such generated black box has a unique public / private key pair. The black box server then delivers the generated black box to the DRM system, and the DRM system installs the delivered black box therein.

Independent claim 122 recites subject matter similar to that in independent claim 106, but from the point of view of the DRM system. Independent claim 138 recites subject matter similar to that in independent claim 106, but from the point of view of the black box server. Independent claim 152 recites subject matter similar to that in independent claim 122, but in the form of a computer-readable medium having computer-executable instructions thereon for performing the method of claim 122. Independent claim 168 recites subject matter similar to that in independent claim 138, but likewise in the form of a computer-readable medium having computer-executable instructions thereon for performing the method of claim 138.

Applicants respectfully submit that the § 103(a) rejection is prima facie improper for several reasons that result in Applicants not clearly understanding the bases of the rejection of the claims under § 103(a), and that because the rejection is prima facie improper, Applicants are unable to fully respond to the § 103(a) rejection. Under the circumstances, then, Applicants limit their remarks in response to the § 103(a) rejection to comments regarding why the rejection is prima facie improper and why the Applicants cannot be expected to clearly understand the bases of the rejections, inasmuch as any substantive comments on the rejection could be unnecessarily construed as creating prosecution history estoppel with regard to such claims.

Firstly, Applicants respectfully submit that the Examiner has improperly taken Official Notice in rejecting of the claims under § 103(a). In particular, the

Examiner at or about page 3 has taken Official Notice of at least 30 individual claim elements or limitations, each as underlined within the pages of the Office Action.

Applicants respectfully point out that, as stated in MPEP 2144.03, the rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art. In particular, the Examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art (emphasis added). Thus, Applicants respectfully submit that official notice is meant to be taken with regard to facts that on their face are undeniable, such as 'water boils upon being sufficiently heated', 'gravity pulls objects toward each other', and 'gasoline is combustible'. In contradistinction, Applicants also respectfully submit that official notice is not meant to be taken with regard to facts such as particular steps that a computing device might be programmed to take, or particular items that may be included with a computing device, especially if such computing device can be operated with other steps or without the particular items.

MPEP 2144.03 also sets forth that assertions of technical facts in areas of esoteric technology must always be supported by citation of some reference work, and allegations concerning specific 'knowledge' of the prior art, which might be peculiar to a particular art should also be supported. Significantly, officially noticed facts are intended to fill the gaps which might exist in an evidentiary showing and should not comprise the principle evidence upon which a rejection is based (emphasis added). If the applicant traverse such an assertion, the examiner should cite a reference in

support of his or her position. Thus, official notice should be taken to support a rejection, not as the primary means of making the rejection.

Applicants respectfully submit that the citing of official notice with respect to so many elements or limitations goes beyond merely 'filling the gaps', and instead improperly transits to the principal evidence upon which the Examiner is basing the rejection. In particular, and as may be seen from pages 3-10 of the Office Action the underlined elements or limitations collectively form a mountain of Official Noticing. Tellingly, the Examiner does not even specifically cite to the Krishnan reference, which as set forth by the Examiner is the main basis of the Section 103 rejection, and only cites to the Stefik reference for what may be 'suggested' thereby. Parenthetically, it is to be noted that the Examiner in making the Section 103 rejection also cited to the Ginter reference even though such Ginter reference has not been formally employed by the Examiner in any capacity with regard to the Section 103 rejection.

Applicants also respectfully submit that many if not most of the elements or limitations of which Official Notice are taken are not even facts outside of the record which are capable of instant and unquestionable demonstration as being 'well-known' in the art. For example, the Examiner takes Official Notice that it is known, prior to requesting a new black box, to determine that a previously installed black box is non-unique (claim 107) or non-current (claim 108). Likewise, the Examiner takes Official Notice that it is known to have a first previously installed black box with a public / private key pair different from the public / private key pair of a generated black box, as in claim

111. Unquestionably, such facts are not capable of instant and unquestionable demonstration as being well known, and can certainly be open to question.

Although too numerous to mention herein, Applicants likewise submit that many if not most of the other elements or limitations for which Official Notice are taken are likewise not truly facts capable of instant and unquestionable demonstration as being well known, and instead certainly open to question. Thus, Applicants request that the Examiner support each and every taking of Official Notice with suitable evidence.

Secondly, Applicants respectfully submit that the Examiner has not provided a proper basis for rejecting the claims in view of the Krishnan and Stefik references. In particular, Applicants note that the Examiner generally submits at pages 1 and 2 of the Office Action that a DRM [system] obviously having a structure / (black box) with encryption / decryption keys inside "is very obvious", and that all of the elements recited in claim 106 are "merely communications . . . between 2 parties to utilize encryption / decryption keys. Thus, the Examiner fails to address how any of the Krishnan or Stefik references discloses or suggests any of the specific elements recited in claim 106, but merely asserts that claim 106 is obvious because such claim recites communications elements. Applicants respectfully submit that such an assertion is prima facie improper.

Thereafter, the Examiner does cite to the Stefik reference as 'suggesting' communications. However, the citation to the Stefik reference does not at all address any of the specific elements recited in claim 106, but instead merely discloses some facts regarding public key / private key cryptography. Here, Applicants respectfully

submit that the citation to the Stefik reference is prima facie improper as being irrelevant, and is also prima facie improper as not including any identification of the specific location from which such citation was obtained within the Stefik reference.

Applicants also note that the Office Action also includes other citations to the Stefik reference and to a non-asserted Ginter reference as 'suggestive', but that in fact do not at all address any of the specific elements recited in the corresponding claim(s) under examination. Again, Applicants respectfully submit that such citations to the Stefik reference and Ginter reference are prima facie improper as being irrelevant, and are also prima facie improper as not including any identification of the specific location from which such citation was obtained within the Stefik reference or Ginter reference.

Thirdly, Applicants do not clearly understand the bases of the rejection of the claims under § 103(a) inasmuch as the Examiner in stating a case for the § 103(a) rejection does not appear to refer to any location within the Krishnan or Stefik references as disclosing or suggesting any of the elements recited in independent claims 106, 122, 138, 152, or 168. In particular, the Examiner does not anywhere in the Office Action explain how the cited references, either alone or combined, might suggest or disclose that a computer having a DRM system with a black box for performing decryption and encryption functions interacts with a black box server to obtain the black box. Likewise, the Examiner does not anywhere in the Office Action explain how the cited references, either alone or combined, might suggest or disclose that to do so, the DRM system requests the black box from the black box server and the black box server

generates the black box, where such generated black box is unique and has a public / private key pair, and that the black box server then delivers the generated black box to the DRM system, and the DRM system installs the delivered black box therein, as is variously required by independent claims 106, 122, 138, 152, and 168, and by all claims depending therefrom. Again, the Examiner does cite to the unspecified portions of the Stefik reference and an unasserted Ginter reference, but not in any way relevant to the aforementioned recited claim elements.

Too, the Examiner does acknowledge that at least claim 106 requires such elements, but in doing so at the top of page 2, the Examiner ignores that such claim elements are with regard to a black box, and instead improperly chooses to cast such claim elements as being with regard to encryption / decryption keys only. As may be appreciated from the specification of the present application, a black box such as may be employed by the DRM system of the present invention is not merely a set of keys, but is a device that has a set of keys associated therewith and that performs cryptographic functions for the DRM system based on the associated set of keys. Thus, the black box can perform symmetric and asymmetric encryption and decryption, both to obtain other keys from DRM licenses and content and to decrypt a content key for a piece of DRM content and then decrypt the content therewith. Thus, and again, Applicants respectfully submit that the failure of the Examiner to consider at least claim 106 in terms of the recited black box and not in terms of keys is prima facie improper.

Fourthly, the Examiner at or about page 13 ambiguously states that all claimed limitations are inherent or well-known, and old, and that such limitations are

'easily recognized to be components of a computer system'. According to the Examiner, "cited prior art's limitations are not necessary [sic] spelled-out exactly claimed languages, [sic]" because these prior references are also directed to a similar process / system for 'transferring money from a safe'. Leaving aside that the present application is not especially concerned with transferring money from a safe, the Examiner continues at some length with similar ambiguous generalities.

Applicants respectfully submit that such blanket statements cannot satisfy the requirement that the Examiner make a prima facie case of obviousness under Section 103(a). In particular, Applicants respectfully point out that such blanket statements amount to a blanket rejection of the claims without providing any specific details. Moreover, such blanket statements do not at all provide any indication of why the cited references should or could be combined to produce the invention recited in the claims.

Further, Applicants respectfully submit that a proper rejection cannot be based merely on the fact that computer systems exist and can therefore be programmed in a manner to produce the invention recited in the claims, as the Examiner implies. Such a rejection amounts to an argument that the present invention is inherent in a computer system. With regard to "inherent", then, Applicants direct the Examiner's attention to MPEP § 2112, where it is discussed that a rejection based on inherency is proper under Section 102 only and not under Section 103. Moreover, inherency can be established only by extrinsic evidence that makes it clear that the missing descriptive matter is necessarily present in the thing described in the reference,

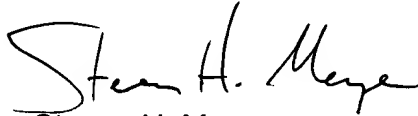
and that it would be so recognized by persons of ordinary skill. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

Applicants respectfully submit that based on all of the above reasons, the Examiner has not clearly set forth a prima facie basis for explaining the manner in which the Krishnan reference should or could be combined with the Stefik reference and the "Official Notice" to produce the invention recited in claims 106-181. Moreover, without such explanation of how the references are applicable to the claims, Applicants respectfully submit that they are unable to fully and completely respond to the rejection in the manner in which they would like to do so.

Accordingly, and for all of the aforementioned reasons, Applicants respectfully submit that the Examiner has not made a prima facie showing that the combination of the cited references, as set forth by the Examiner, makes obvious claims 106-181. Applicants also respectfully submit that at any rate the combination of the cited references, as set forth by the Examiner, do not in fact make obvious claims 106-181. Instead, Applicants respectfully submit that claims 106-181 are not in fact obvious in view of the cited references, and accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection.

In view of the foregoing discussion, Applicants respectfully submit that the present application, including claims 106-181, is in condition for allowance, and such action is respectfully requested. Should the Examiner disagree, Applicants respectfully request that the Examiner telephone the undersigned at the number below to arrange an in-person interview with the Examiner and the Examiner's supervisor to discuss the present Office Action.

Respectfully submitted,



Steven H. Meyer
Registration No. 37,189

Date: April 15, 2003

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